

REMARKS ADDRESSING RESUBMISSION OF AMENDMENT

Responsive to the Office Action of January 24, 2007, indicating a non-compliant amendment was filed, please consider this corrected resubmission of the after-final amendment filed December 26, 2006. Specifically, the previous amendment inadvertently included an underline mark within claim 8 that appeared to indicate an amendment was presented to the claim, yet the status of the claim was not indicated as "Currently Amended." Applicant has corrected claim 8 to remove the erroneously indicated underlining. If necessary, please charge any fees due to Deposit Account No. 17-0055.

RESUBMITTED REMARKS/ARGUMENTS

Claims 1-9 and 11-22 are pending in the present application. In the Office Action of October 24, 2006, claim 11 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Additionally, claims 1, 4-9, 44-12 and 14-19 were rejected under 35 U.S.C. § 102(a) as being unpatentable over Evans (U.S. Patent No. 5,924,074), in view of Lewis et al. (U.S. Application No. 2003/0200119 A1). Claims 2-3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans and Lewis et al. in further view of Denny (U.S. Patent No. 6,687,676). Claims 13, and 21-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans and Lewis et al. in further view of Mayaud (U.S. Patent No. 5,845,255). Finally, claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans and Lewis et al. in further view of Lee ("Fujitsu Pen Computer Will Ship with Windows 95").

Regarding the rejection of claim 11 under §112, second paragraph, Applicant has canceled the claim. Accordingly, the rejection must be withdrawn.

Regarding the rejection of claim 1 as unpatentable over Evans in view of Lewis et al., Applicant respectfully disagrees with the asserted interpretation of the art and, furthermore, believes that the proffered rejection is improper. That is, the rejection must be withdrawn because the Evans cannot be combined with Lewis et al. in the manner presented in the Office Action because Evans teaches away from the claimed invention. In fact, Evans teaches directly away from the very proposition

for which Lewis et al. was cited. Hence, the rejection is improper and must be withdrawn.

When determining obviousness “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP §2141.02 citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). When considering the reference in its entirety, three criteria must be affirmatively met by the Examiner in proffering the rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP §2143.

Additionally, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP §2143 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In the case at hand, Applicant previously showed in the Response of July 13, 2006, that Evans does not teach the present invention. That is, Evans does not teach or suggest using the selection of a diagnosis code to serve as a gatekeeper to access the additional information. In fact, Evans, when referring to Fig. 10, states that the physician may access optional practice guidelines that allow the physician to consult resources regarding alternative treatments for various conditions, which are accessible irrespective of the selection of a diagnosis code. See col. 7, ll. 52-61. That is, Fig. 10 clearly shows that this treatment information may be obtained directly from the patient data capture box 140, which does not require the input of diagnosis codes.

In this regard, Evans clearly teaches away from the claimed invention. The Office Action acknowledged the shortcomings of the previous rejection based on Evans but attempted to overcome the shortcomings of the rejection by

modifying/supplementing Evans with Lewis et al. This is clearly impermissible under MPEP §§ 2141.02 and 2145 because a reference cannot be modified in a manner contrary to an express teaching. Evans expressly teaches that the physician may access optional practice guidelines that allow the physician to consult resources regarding alternative treatments for various conditions, which are accessible irrespective of the selection of a diagnosis code. See col. 7, ll. 52-61. Lewis et al. cannot be used to modify Evans to require diagnosis codes before access to these resources are permitted because Evans expressly teaches away from such a modification. Therefore, the present rejection must be withdrawn.

Hence, no basis of rejection remains with respect to claim 1. Accordingly, claims 2-9 and 12-22 are in condition for allowance at least pursuant to the chain of dependency. That is, as addressed in detail in the Response of July 13, 2006, Applicant respectfully disagrees with the Examiner with respect to the art as applied to claims 2-9 and 12-22. However, in light of these claims depending from what is believed to be an allowable claim, Applicant does not believe additional remarks are necessary and, therefore, requests allowance of claims 2-9 and 12-22 at least pursuant to the chain of dependency.

In light of these remarks and amendments, it is believed that claims 1-9 and 12-22 are now in condition for allowance and allowance is respectfully requested. Though no fee is believed due as a result of this communication, please charge any fees due to Deposit Account No. 17-0055.

Respectfully submitted,

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